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Michelle Q. Wang Baldonado

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EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT

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2152

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/717,278
Filing Date: November 22, 2000
Appellant(s): WANG BALDONADO ET AL.

Patrick J. S. Inouye, Reg. No. 40297
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/18/2006 appealing from the Office action mailed 5/12/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

GB 2 324 627 A SIMONI JR. and PAN 10-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-14, and 16-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Richard Simoni Junior and Douglas Pan (UK Patent Application Number GB 2 324 627 A), hereinafter referred to as Pan.

Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a method, an information storage media, or an alternative system are rejected under the same rationale applied to the described claim.

Pan has disclosed:

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- <Claims 1, 7, 13, and 19>

An electronic message management system comprising: a digest specification device that allows a user to obtain a plurality of digests from an information stream comprising a plurality of candidate messages by allowing the user to specify a set of one or more sender-independent message-based rules for each digest, wherein each set of one or more sender-independent message-based rules specifies one or more characteristics of the candidate messages; an information selection device that monitors the information stream and selects one or more of the plurality of candidate messages in the information stream that satisfy all of the rules in at least one of the sets of sender-independent message-based rules for at least one of the plurality of digests; and an electronic message management device that determines, for each of the selected candidate messages, which of the plurality of digests corresponds to the set of sender-independent message-based rules satisfied by the particular selected candidate message, that integrates each of the selected candidate messages into their respective corresponding digests, and that determines and updates the digest based on one or more of the sender-independent message-based rules that specify characteristics of the digest (page 33, line 1 through page, 34, line 9 and page 1, line 13 through page 2, line 9).

- <Claims 2, 8, and 14>

The system of claim 1, further comprising a digest management device that delivers the digest to a predetermined destination upon satisfaction of at least one of the one or more sender-independent message-based rules (figure 7 and page 33, lines 15-20).

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- <Claims 3, 10, and 16>

The system of claim 1, further comprising an information sampling device that delivers the selected candidate messages to a predetermined destination based on one or more of the sender-independent message-based rules (figure 7 and page 33, lines 15-20).

- <Claims 4, 24, and 25>

The system of claim 1, further comprising a rule management device that manages the one or more sender-independent message-based rules (page 33, line 21 through page 34, line 2 and page 16, line 12 through page 17, line 6).

- <Claims 5, 11, and 17>

The system of claim 1, wherein the one or more sender-independent message-based rules include a Boolean comparison, a statistical-based selection criteria, a fuzzy logic based selection criteria, a keyword based selection criteria, a date, a subject, a recipient, or a sender-based selection criteria (figure 13 and page 33, lines 9-12).

- <Claims 6, 12, and 18>

The system of claim 1, wherein the electronic message is at least one of an email, an electronic message from a mailing list, and a bulletin board posting (page 33, lines 9-14).

- <Claims 21, 22, 23, and 20>

The electronic message management system of claim 1, wherein the electronic message management device selects one or more of the candidate messages which meet one or more supplemental selection criteria (figure 13 and page 33, lines 9-12).

Since all the limitations of the invention as set forth in claims 1-8, 10-14, and 16-25 were disclosed by Pan, claims 1-8, 10-14, and 16-25 are rejected.

(10) Response to Argument

In the remarks, the appellant has argued:

- <Argument 1>

Concerning the independent claims, Pan fails to disclose digests.

- <Argument 2>

Concerning the independent claims, Pan fails to disclose sender-independent rules.

- <Argument 3>

Concerning the independent claims, Pan fails to disclose a plurality of digests, or Pan is many-to-one in this regard.

- <Argument 4>

Concerning the independent claims, Pan fails to disclose obtaining digests from an information stream, or Pan requires messages from newsgroups.

- <Argument 5>

A prima facie case of anticipation has not been shown with respect to the independent claims.

Before discussing each argument in detail, it is noted that the appellant has stated that each independent claim (and its dependents) should be argued separately. However, all the independent claims (claims 1, 7, 13, and 19) recite similar limitations and are only different in implementation (system, method, etc.). It is well accepted in the computer arts that an invention may be claimed in various implementations (in this case an electronic message management system, a method for managing electronic messages, and an information storage media

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comprising information that manages electronic messages), but it is the specific limitations set forth in the claims which will be given the most weight in determining patentability.

Furthermore, the appellant's arguments concerning the limitations of the claims (arguments 1-5 stated above) do not contain any argument whatsoever as to reasons why different implementations (system, method, etc.) would be distinguished over each other. Each argument of arguments 1-5 is simply restated for each independent claim and concerns the same limitations. Thus, the examiner sees no reason why each independent claim need be argued separately for each argument 1-5. Each argument 1-5 will be addressed once below and the comments therein apply to each of the independent claims.

In response to argument 1, it is maintained that Pan does disclose digests as recited in the independent claims. The previously cited lines to Pan (see the rejection of claim 1 above) disclose the creation of custom newsgroups which clearly meet the "digests" of the claim. The appellant states that Pan's "news server is passive and accepts messages newly posted for users without monitoring or selecting." However, this statement ignores the custom newsgroup functionality of Pan's system. Once the news server has acquired messages, the super-server application allows for the filtering (i.e. monitoring and selecting) of messages across the newsgroups to be included in a custom newsgroup which is sent to the user. As Pan states at page 33, lines 5-7, "The custom newsgroup is an aggregation of messages that meet a set of criteria specified by the user or the administrator of super-server application 114." This aggregation of messages clearly meets the limitation of a digest. Concerning the "information stream" aspect of the independent claims, see the response to argument 4 below.

In response to argument 2, it is maintained that Pan does disclose sender-independent rules as recited in the independent claims. The previously cited lines to Pan (see the rejection of claim 1 above) disclose the creation of custom newsgroups based on filtering criteria. This filtering criteria can include subject or keyword criteria, which criteria is clearly sender-independent. The appellant has argued that the criteria “is dependent upon the originator of each message, which is either a newsgroup or newsgroup hierarchy.” Although Pan does state that criteria can be specified across a certain newsgroup, the appellant is mistaken in naming the newsgroup “the originator” of each message. The newsgroup is simply a collection of messages on the same topic. The originator of each message is the user who posts the message. Pan’s filtering criteria allow the user creating the custom newsgroup to filter messages based on subject or included words, which is different than filtering based on those users who posted the messages. The claims define “sender-independent message-based rules” and rules that filter based on the subject of a message or words included in a message are clearly “message-based” and “sender-independent”. Furthermore, even if selecting a certain newsgroup across which to filter could somehow be connected to the origination of the content by the users who posted it, Pan’s system allows for the criteria to be applied across all groups. Thus, in this instance the filter would further be newsgroup-independent. See Pan, figure 13.

In response to argument 3, it is maintained that Pan does disclose a plurality of digests as recited in the independent claims. The previously cited lines to Pan (see the rejection of claim 1 above) disclose the creation of custom newsgroups. Clearly Pan’s system is enabled to create

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multiple custom newsgroups which meets the limitation of a plurality of digests. The appellant is correct in stating that Pan is many-to-one insofar as each of Pan's custom newsgroups includes messages from many different regular newsgroups. However, Pan's system is nowhere limited to one single custom newsgroup at all times. Different filtering criteria can be applied a plurality of times across the same regular newsgroups to create multiple custom newsgroups that draw from the regular newsgroups. If, based on this reasoning, the appellant is to argue that the custom newsgroups are not created simultaneously based on the filtering, this would not be relevant to the current limitations of the claims. The independent claims recite selecting messages "for at least one of the plurality of digests". See, for example, claim 1, lines 10-12.

In response to argument 4, it is maintained that Pan does disclose obtaining digests from an information stream as recited in the independent claims. The previously cited lines to Pan (see the rejection of claim 1 above) disclose the creation of custom newsgroups created by applying filtering criteria across several newsgroups. These regular newsgroups include messages stored on a news server where the messages have been posted by a first user and can be accessed by a second user. The appellant is correct in stating that Pan requires messages from newsgroups insofar as each of Pan's custom newsgroups culls messages from different regular newsgroups. However, Pan's custom newsgroups still meet the limitation of being obtained from an information stream. The specification defines an information stream as including any serial message stream or serial database. See page 9, lines 19-22. The news server is a database for messages posted serially by users. Furthermore, the super-server application filters the messages on the news server. This application functions between the first user (or originator)

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and the second user (or recipient) of the message, thereby taking action on the information stream. The super-server application monitors messages that have been sent from a first user (posted to the news server) and that will be sent on to a second user (accessed by the user checking his custom newsgroup). The claims do not further define "an information stream" in any way so as to distinguish the claimed information stream over the messages being posted and filtered in Pan's system.

In response to argument 5, it is maintained that a prima facie case of anticipation has been shown with respect to the independent claims. In this argument, again, the appellant states that "Pan does not disclose a device that delivers newsgroups based on a set of sender-independent message-based rules." Concerning this, see the response to argument 2 above. The appellant also states that "Sorting of newsgroups is different from digesting because digesting allows multiple electronic messages to be collected and sent as a single message." Again, this is exactly what Pan's system does. The custom newsgroup is an aggregation of messages that meet a set of criteria. Again see Pan, page 33, lines 1-14.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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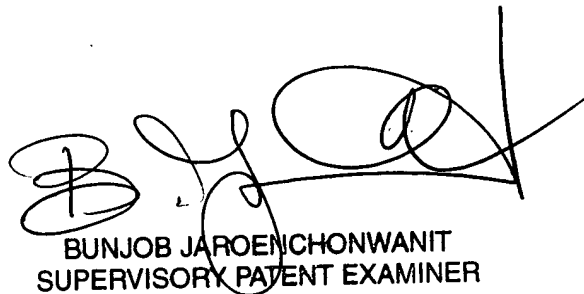
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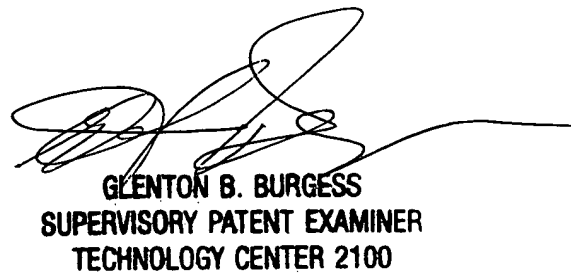
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